

REMARKS

Claims 1-24 are currently pending in the subject application and are presently under consideration. New claim 25 has been added to emphasize various novel aspects of the subject invention – this claim does not raise new issues requiring additional search or consideration over that of the originally filed claims. Claims 1, 5, 12, 21 and 24 have been amended herein. Claims 2-4 and 13-14 have been cancelled. A complete listing of the claims is provided in revised amendment format at pages 2-5. Amendments to the specification that correct minor informalities (*e.g.*, typographical errors) can be found at pages 6-7, while a description of drawing amendments is located at page 8. Included herewith are a replacement sheet and an annotated sheet showing changes to the drawings.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Objection to the Drawings

The drawings have been objected to for being inconsistent with the specification. Amendments have been made herein that are believed to cure the inconsistencies. Accordingly, withdrawal of this rejection is respectfully requested

II. Objection to the Specification

The specification has been objected to because of several informalities. The specification has been amended herein at pages 6 and 7 to cure such informalities. Hence, this objection should be withdrawn.

III. Rejection of Claims 1-11 and 21 Under 35 U.S.C. §112, Second Paragraph

Claims 1-11 and 21 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite. The amendments herein are believed to cure any perceived indefiniteness. Withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 1-3, 5, 6, 12, 13, 15, 16, and 22-24 Under 35 U.S.C. §102(e)

Claims 1-3, 5, 6, 12, 13, 15, 16, and 22-24 stand rejected under 35 U.S.C. §102(e) as being anticipated by Zimniewicz, *et al.* (U.S. 6,473,771). Withdrawal of this rejection is respectfully requested for at least the following reason(s).

Claims 1 and 24 have been amended to recite limitations of presently cancelled claims 2-4, and claim 12 has been amended herein to recite limitations of claims 13 and 14. As conceded by the Examiner in Paper No. 5, Zimniewicz, *et al.* fails to disclose, teach or suggest *a dependency engine that ... adds necessary components to correct dependency* as recited in claim 1; *a dependency engine programmed to ensure proper dependency between selected components*, as recited by claim 24; and *adding components necessary to ensure proper dependency when improper dependency exists based on the selected components*, as recited in claim 12.

Accordingly, it is respectfully submitted that Zimniewicz, *et al.* does not anticipate the subject invention as recited in claims 1, 12 and 24, and claims 2, 3, 5, 6, 13, 15, 16, 22 and 23, which respectively depend there from, and this rejection should be withdrawn.

V. Rejection of Claim 1 Under 35 U.S.C. §102(e)

Claim 1 stands rejected under 35 U.S.C. §102(e) as being anticipated by Curtis (U.S. 6,422,754). Withdrawal of this rejection is requested for at least the following reasons. Curtis, *et al.* fails to disclose, teach, or suggest each and every claim limitation.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that *“each and every element* as set forth in the claim *is found*, either expressly or inherently described, *in a single prior art reference.*” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999)(quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added).

Curtis, *et al.* is concerned with creating a cross-platform installer program for installing *a single application* program onto a computer employing one of a plurality of different operating systems and providing system component dependency checking such that dependent components can be installed on a system prior to installing a depending-application program. In contrast,

claim 1 recites, *inter alia*, providing an installation procedure for a plurality of application or service components. Moreover, amended claim 1 now recites limitations of former claims 2 and 4 (canceled herein), which the Examiner concedes is not disclosed or taught by Curtis, *et al.* Accordingly, this rejection should be withdrawn.

VI. Rejection of Claims 4 and 14 Under 35 U.S.C. §103(a)

Claims 4 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Zimniewicz, *et al.* (U.S. 6,473,771) in view of Cohen, *et al.* (U.S. 6,487,713). Withdrawal of this rejection is requested for at least the following reason. Claims 4 and 14 have been cancelled without prejudice or disclaimer herein. Hence, this rejection is moot and should be withdrawn

VII. Rejection of Claims 7-8 and 17-18 Under 35 U.S.C. §103(a)

Claims 7-8 and 17-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zimniewicz, *et al.* (U.S. 6,473,771) in view of Curtis, *et al.* (U.S. 6,442,754). Withdrawal of this rejection is requested for at least the following reasons.

Zimniewicz, *et al.* is not proper citable art with respect to the present application pursuant to 35 U.S.C. §103(c) because both the subject application and the cited reference were subject to an obligation of assignment to Microsoft Corporation at the time the invention was made. Curtis, *et al.* does not make up for the absence of Zimniewicz, *et al.* Furthermore, even if both references were properly citable and combinable it is submitted that they would not make obvious the subject claimed invention. In view of the foregoing, this rejection should be withdrawn.

VIII. Rejection of Claims 9-11 and 19-21 Under 35 U.S.C. §103(a)

Claims 9-11 and 19-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zimniewicz, *et al.* (U.S. 6,473,771) in view of Curtis, *et al.* (U.S. 6,442,754), and further in view of Bunnell (U.S. 6,119,122). Withdrawal of this rejection is requested for at least the following reasons.

Zimniewicz, *et al.* is not proper citable art with respect to the present application pursuant to

35 U.S.C. §103(c) because both the subject application and the cited reference were subject to an obligation of assignment to Microsoft Corporation at the time the invention was made. Curtis, *et al.* and Bunnell fail to make up for the absence of Zimniewicz, *et al.* Furthermore, it is submitted that even if all the references were properly citable and combinable they would not make obvious the subject claimed invention. Accordingly, the rejection of claims 9-11 and 19-21 should be withdrawn.

IX. Rejection of Claims 2-4, 12-14, and 23 Under 35 U.S.C. §103(a)

Claims 2-4, 12-14, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Curtis, *et al.* (U.S. 6,442,754) in view of Cohen, *et al.* (U.S. 6,487,713). Withdrawal of this rejection is requested for at least the following reasons.

The Examiner may not summarily dismiss the claimed invention as obvious based on 20-20 hindsight where applicants' specification provides the only teaching to make the claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j) *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.* See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

There is not proper motivation to combine the teachings of Curtis, *et al.* and Cohen, *et al.* Curtis, *et al.* discloses a system and method for checking and if necessary installing dependant components required for the installation of a single application program. Curtis, *et al.* is not concerned with installation of a plurality of applications in a suite, for example, or producing an installation procedure based on dependencies for a plurality of applications or service components as disclosed by the subject invention in claims 1 and 12. Thus, it is readily apparent

that a person of skill in the art at the time of invention or conception would not employ the user interface of Cohen, *et al.* to allow users to select a plurality of applications that they would like to install. Furthermore, the user interface of Cohen, *et al.* is utilized to facilitate editing of source code files and does not relate to or recognize problems associated with *installing* a plurality of applications or service components across one or more computers. Accordingly, there would be no reason for one skilled in the art to consult Cohen, *et al.* when faced with the problem of installation of components across computers, without knowledge of the subject claimed invention. Thus, the purported obviousness conclusion based on the foregoing combination appears to be based on improper hindsight, in which the instant application provides the missing teaching and motivation for the combination. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in Applicants' specification. This sort of rationale has been condemned by the CAFC; see, for example, *Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987). Accordingly, this rejection should be withdrawn.

X. Rejection of Claims 5-8, 15-18, and 22 Under 35 U.S.C. §103(a)

Claims 5-8, 15-18, and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Curtis, *et al.* (U.S. 6,442,754) in view of Cohen, *et al.* (U.S. 6,487,713), and further in view of Lewis, *et al.* (U.S. 5,761,380). Withdrawal of this rejection is requested for at least the following reasons.

Claims 2-8, 15-18, and 22 depend from claims 1 and 12. Lewis, *et al.* fails to make up for the aforementioned deficiencies of Curtis, *et al.* and Cohen, *et al.* Accordingly, this rejection should be withdrawn.

XI. Rejection of Claims 9-11 and 19-21 Under 35 U.S.C. §103(a)

Claims 9-11 and 19-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Curtis, *et al.* (U.S. 6,442,754) in view of Cohen, *et al.* (U.S. 6,487,713), further in view of Lewis, *et al.* (U.S. 5,761,380), and further in view of Bunnell (U.S. 6,119,122). Withdrawal of this rejection is requested for at least the following reasons.

Claims 9-11 and 19-21 depend directly or indirectly from claims 1 and 12. Bunnell does not make up for the aforementioned deficiencies of the primary references with respect to claims 1 and 12. Hence this rejection should be withdrawn.

XII. Rejection of Claim 24 Under 35 U.S.C. §103(a)

Claim 24 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Curtis, *et al.* (U.S. 6,442,754) in view of Lee, *et al.* (U.S. 6,158,001). Withdrawal of this rejection is requested for at least the following reasons.

Claim 24 has been amended to recite the limitations of former claims 2-4. As conceded by the Examiner, Curtis fails to disclose, teach, or suggest identifying selected components to be installed and a dependency engine adding necessary components to ensure proper dependency as recited by amended claim 24. Lee, *et al.* fails to make up for these deficiencies of Curtis, *et al.* Accordingly, this rejection should be withdrawn.

CONCLUSION

The present application is believed to be condition for allowance in view of the above amendments and comments. A prompt action to such end is earnestly solicited.

In the event any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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